

Application No. 10/713,535  
Reply to Office Action of January 24, 2006

Docket No.: PI 1615 USNA

### REMARKS

This Amendment is responsive to the Office Action mailed January 24, 2006. Applicants respectfully requests reconsideration of the application as amended.

Amendments were made throughout the specification to correct minor errors, as requested by the Examiner. No new matter has been introduced.

Claims 1-6 are currently pending in this application and are subject to examination. Claim 1 has been amended to correct a misspelling by replacing the word "present" with the word "presence."

### Rejection Under 35 U.S.C. § 103(a)

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,376,714 (hereinafter, the '714 patent) to Allgeier et al. Specifically, the Examiner alleges that the processes of the present claims are *prima facie* obvious because the claimed operational pressure of at least about 2000 psig fails to render them patentably distinct from the process disclosed in the '714 patent. Applicant respectfully disagrees and requests reconsideration of the rejection for the following reasons.

For a claim to be obvious in view of a prior art reference, there must be some suggestion or motivation in the reference to modify it so as to encompass the claimed invention. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). In effect, the prior art reference would "teach away" from the proposed modification. *Id.* A *prima facie* case of obviousness is not established if the prior art reference teaches away from the proposed modification. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.").

The '714 patent is generally directed to a process for hydrogenating dinitriles with hydrogen in the presence of a catalyst and a modifier at lower pressures. The '714 patent

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discloses 300-1500 psig as the pressure range in which its hydrogenation process is conducted, with the substantially lower range of 350-550 psig being preferred (See column 4, lines 45-48). In addition, none of the processes in the examples of the '714 patent were carried out at a pressure higher than 500 psig. (See Examples 1-6 and Comparative Examples A-C). The intended purpose of conducting the '714 patent process in this pressure range is to enable it to be carried out on a commercial scale on low pressure equipment, which is cheaper due to the relatively higher cost of commercial scale, high pressure equipment (See column 1, lines 24-43).

In contrast, the present claims are directed to processes for hydrogenating dinitriles with hydrogen in the presence of a catalyst and a modifier at higher pressures, i.e., pressures at least about 2200 psig. For example, a preferred range is 2200 to 8000 psig, and all of the processes in the examples of the present application were carried out at 4500 psig. (See page 8, examples 1-4). The intended purpose of conducting the presently claimed processes at higher pressure is to enable them to be carried out on preexisting commercial scale, high pressure equipment, i.e., equipment that operates at pressures in excess of 2000 psig (See page 1, lines 31-34).

The Examiner alleges that the presently claimed operating pressure is simply an optimized variable and is thus an obvious modification of the '714 patent process. However, increasing the pressure employed in the '714 patent process to about 2200 psig or above would render this process unsatisfactory for its intended purpose. As pointed out above, the intended purpose of conducting the '714 patent process at 300-1500 psig, preferably 350-550 psig, is so that it can be conducted using *low pressure* equipment. Increasing the operating pressure to that of the present claims precludes this, since hydrogenation at such pressures must be conducted on *high pressure* equipment. Since the modification of the operating pressure proposed by the Examiner would render the '714 patent process unsatisfactory for its intended purpose, there can be no suggestion or motivation to make this proposed modification. The '714 patent sought a low operating pressure process and discourages a person skilled in the art from carrying out its process at the operating pressures of the present claims. Thus, the '714 patent teaches away from conducting its process at the operating pressures of the present claims. As such, the Examiner has failed to establish that the present claims are *prima facie* obvious. Accordingly, Applicant respectfully submits that the present claims are nonobvious and requests that the obviousness rejection be withdrawn.

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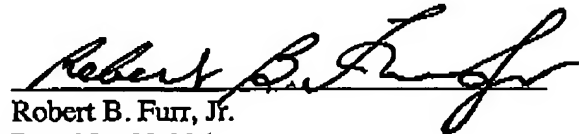
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In view of the above amendments and arguments, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, should any fees be required in connection with this Amendment, authorization is hereby made to charge any fees due or outstanding, including any extension fees, or credit any overpayment, to Deposit Account No. 50-3223 (INVISTA North America S.à r.l.).

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Respectfully submitted,



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